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Amdt. dated 12/21/2004  
Reply to OA mailed 09/21/2004

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### REMARKS

This Amendment is responsive to the Office Action identified above, and is further responsive in any other manner indicated below.

### PENDING CLAIMS

Claims 1-7 were pending in the application, under consideration and subject to examination at the time of the Office Action. Unrelated to any prior art, scope or rejection, appropriate claims have been amended in order to adjust a clarity and/or focus of Applicant's claimed invention. That is, the amendments to the claims are unrelated to any prior art or scope adjustment, and are simply clarified claims in which Applicant is presently interested. At entry of this paper, Claims 1-7 remain pending in the application for consideration and examination.

### CLAIM AMENDMENTS

Unrelated to any prior art, scope or rejection, Claims 1-7 have been minorly amended to clarify the claims and correct any typographical or grammatical errors noted.

### DOUBLE PATENTING REJECTION - TRAVERSED/NOT SUPPORTED

The non-statutory double patenting rejection is respectfully traversed because such rejection does not provide the factual analysis required for such rejections under U.S. patent law, i.e., the Examiner has not satisfied his/her initial burden to adequately support the rejection. More particularly, MPEP §804 instructs:

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Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 USC 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 US 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 USC 103 are employed when making an obviousness-type double patenting analysis. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of non-obviousness.

Any obviousness-type double patenting rejection should make clear:

- (A) The differences between the invention defined by the conflicting claims - a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is an obvious variation of the invention defined in a claim in the patent.

The rejection does not make clear the differences, or the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent, but merely states limitations that are believed to be claimed, e.g., that image signals are applied to the scanning circuit and signal circuit to drive the pixel elements, and that the clock signal controls transmission of image signal to the signal circuit to the pixel elements, and then alleges that the claimed invention in the present application would have been obvious because of the disclosure in the application itself. However, as required by MPEP §804, the same determination of obviousness in a rejection under 35 USC §103 must be used in a non-statutory double-patenting

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rejection, and as indicated in the requirements to support a rejection under 35 USC §103, with reference to the decision *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988), whether a particular combination might be "obvious to try" is not a legitimate test of patentability, and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. As further noted by the Court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Such requirements have been clarified in the recent decision in *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), wherein the Court, in reversing an obviousness rejection, indicated that deficiencies of the cited reference cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge." The Court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of reference, simply to "[use] that which the inventor taught against its teacher."...Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.  
(emphasis added)

Therefore, the Examiner has failed to deliver any of the required analysis of the claims pending in the instant application with the features/limitations of the patented

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claims, and therefore has failed to provide proper and adequate grounds for the rejection.

Accordingly, Applicant respectfully traverses the rejection, and submits that the above analysis should be provided in order for the Examiner to satisfy his/her initial burden to support the rejection, or the rejection should be withdrawn.

#### **NON-STATUTORY DOUBLE PATENTING REJECTION - DISCLAIMER FILED**

The alleged obviousness-type double patenting rejection of Claims 1-7 as set forth at Item 2 on page 2 of the Office Action is respectfully traversed. However, in order to travel a path of least resistance to obtaining a patent for the present application, submitted herewith is an executed Terminal Disclaimer to overcome the alleged non-statutory double patenting rejection. Also, as a result of the foregoing, reconsideration and withdrawal of the double patenting rejection of the subject claims are respectfully requested. The above statements, and/or the filing of any Terminal Disclaimer, is not, and should not be taken as, any indication or admission that any part of the rejection is valid, but is merely use of a procedural approach to obviate the rejection. Further, at this point, it is respectfully submitted as a reminder that, if new art is now cited against any of Applicant's minorly amended claims, then it would not be proper to make a next Action final.

#### **RESERVATION OF RIGHTS**

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present

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application are without prejudice or disclaimer of any scope or subject matter. Further, Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, *i.e.*, Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

#### **EXAMINER INVITED TO TELEPHONE**

The Examiner is invited to telephone the undersigned at the local D.C. area telephone 703-312-6600, to discuss an Examiner's Amendment or other suggested action for accelerating prosecution and moving the present application to allowance.

#### **CONCLUSION**

In view of the foregoing amendments and remarks, Applicant respectfully submits that the claims listed above as presently being under consideration in the application are in condition for allowance. Accordingly, early allowance of such claims is respectfully requested.

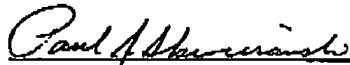
This Amendment is being filed within the shortened statutory period for response set by the 21 September 2004 Office Action, and therefore, no Petition or extension fee is required. To whatever other extent is actually necessary, Applicant respectfully petitions the Commissioner for an extension of time under 37 CFR §1.136. Attached is a Form PTO-2038 authorizing payment of the requisite

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Disclaimer fee; no other/additional fees are required for entry of this paper. Please charge any actual fee deficiency to ATS&K Deposit Account No. 01-2135 (as Case No. 503.37304CC2).

Respectfully submitted,



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Attachments:

Terminal Disclaimer  
Form PTO-2038 (Fee Code 1814)